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OFFICE OF PETITIONS

In re Application of :
Goodson et al. :
Application No. 10/821,307 : DECISION ON PETITIONS
Filed: April 9, 2004 : UNDER 37 CFR 1.78(a)(3) AND
Attorney Docket No. 15999.5 : UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition filed July 14, 2005, which is being treated as a petition under 37 CFR §§1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **Dismissed**.

A petition for acceptance of a claim for late priority under 37 CFR §§1.78(a)(3) and 1.78(a)(6) and is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR §§1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

A reference to add the above-noted, prior filed applications in the amendment to the specification has been filed with the instant petition. However the amendment is not acceptable as drafted

since it improperly incorporates by reference the prior filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew distinction between a permissible 35 U.S.C. §120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The Court specifically stated:

Section 120 merely provides the mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation by reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. *In re deSeversky, supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See *In re deSeversky, supra*. Note also MPEP 201.06(c).

Accordingly, before the petition under 37 CFR 1.78(a)(3) and (a)(6) can be granted , a substitute amendment¹ deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(3) and (a)(6), is required.

Further correspondence with respect to this matter may be addressed as follows:

By mail: Mail Stop Petition

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¹Note 37 CFR 1.121 and 37 CFR 1.116

Any inquiries concerning this decision may be directed to Charlema R. Grant at (571) 272-3215.



Frances Hicks

Petitions Examiner
Office of Petition